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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,700	12/17/2003	Yuichi Kinoshita	D-1563	5694
32628	7590	06/16/2005	EXAMINER	
HAUPTMAN KANESAKA BERNER PATENT AGENTS SUITE 300, 1700 DIAGONAL RD ALEXANDRIA, VA 22314-2848			PICKARD, ALISON K	
			ART UNIT	PAPER NUMBER

3673

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/736,700

Applicant(s)

KINOSHITA, YUICHI

Examiner

Alison K. Pickard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-7 and 9-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "without foaming" added to claim 1 does not appear to be supported in the specification. There does not seem to be any disclosure stating that the coating can not be foamed.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida (5,582,415) in view of Sugimoto (6,575,473).

Yoshida discloses a gasket comprising a metal plate 61 having a bore 62, a coating 71 spaced from the bore, a liquid hole 64, a bead 67, and a second coating 73 on the bead in Figures 24 and 25. As seen in Figure 24, the coatings partly abut each other. Yoshida does not disclose

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a folded portion around the bore. Sugimoto teaches a gasket having a metal plate, a bore, and a coating 15 spaced from the bore 3. Sugimoto teaches forming a folded portion 37 around the bore to seal the bore and to limit compression of sealing beads in the gasket (see col. 9, lines 10-14). As seen in the Figures, Sugimoto shows the fold separate from the bead 36 or coatings 35. Thus the coating of Yoshida would not overlap the fold. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the gasket of Yoshida with a fold around the bore to seal the bore and limit compression of the sealing beads.

Although the coating is not foamed, Yoshida does not disclose a coating with a pencil hardness of 2H-6H. The selection of a known material based on its suitability for its intended use is not considered inventive. See *In re Leshin* 125 USPQ 416 (CCPA 1960). Further, it is known to use coatings having a pencil hardness of 2H-6H on gaskets as evidenced by Udagawa '910. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a coating with a pencil hardness of 2h-6h.

5. Claims 4-6, 8-10, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida '415 in view of Sugimoto '410 as applied to claim 1 above, and further in view of Udagawa (5,769,430).

Yoshida does not disclose that the second coating has a thickness less than the first coating. Udagawa teaches a gasket having a first coating 15 near a bore and second coating 16 near a fluid hole. The second coating is made thinner than the first to create higher surface pressures and effectively seal the bore (see col. 3, lines 27-35). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the first

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coating thicker than the second coating to create a higher surface pressure and effective bore seal.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida in view of Sugimoto in view of Udagawa as applied to claim 6 above, and further in view of Okazaki (6,550,782).

Yoshida does not disclose the bead is a half bead. Okazaki teaches a gasket having a bore and fluid bore. Okazaki teaches using a half bead 6 around the fluid bore 3 to provide a higher surface pressure adjusting function (col. 7, lines 59-62). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a half bead to provide higher surface pressure adjustment.

#### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after


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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison K. Pickard whose telephone number is 571-272-7062. The examiner can normally be reached on M-F (10-7:30), with alternate Friday's off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on 571-272-7049. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Alison K. Pickard  
Primary Examiner  
Art Unit 3676

AP